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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,289	10/13/2000	Robert G. Padingham	584-1033	8885

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EXAMINER

PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,289

Applicant(s)

PADINGHAM ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to the application, filed 2000-10-30
2. The disposition of claims is: claims 1-26 are pending as filed. Claims 1-3, 5, 10, and 12 are independent.

Title

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The claimed invention is noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se.

Furthermore, the claimed invention do not produce a useful, concrete and tangible result therefore they are nonstatutory. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction.

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As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In re Musgrave, 167USPQ 280 (CCPA 1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Carlton-Foss (U.S. 6,058,379).

Carlton-Foss teaches claims:

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1. A system for use on an electronic network for negotiating contracts between at least one buyer and at least one seller, in which proposals may be made or called for by buyers and/or sellers, and in which each party is represented by a software agent (col.2, lines 37-53).
2. A software agent for a party conducting electronic trading, comprising a transaction engine; a negotiation engine driven by the transaction engine; and a store of a plurality of negotiation profiles; and control means responsive to the commercial situation or state of the party to select the optimal negotiation profile appropriate to that situation or state, and to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile (col.2, lines 37-53; col.5, line33-col.7, line 17; col.4, lines 1-29; fig.8).
3. A method of performing automated reverse auction on an electronic network using software agents for buyers and sellers (col.2, lines 37-53).
4. A method according to Claim 3, in which the software agent for each buyer and each seller comprises a transaction engine; a negotiation engine driven by the transaction engine; and a store of a plurality of negotiation profiles; and control means responsive to the commercial situation or state of the party to select the optimal negotiation profile appropriate to that situation or state, and to cause the transaction engine to initiate or conduct e-

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commerce negotiations using the negotiation engine programmed with the selected negotiation profile (col.2, lines 37-53; col.5, line33-col.7, line 17).

5. A method of automated bi-lateral negotiation in which buyers' agents co-operate to produce a call for proposal to purchase collectively from one or more seller (col.2, lines 37-53; col.5, line33-col.7, line 17).

6. A method according to Claim 5, in which each buyer is represented by a software agent.

7. A method according to Claim 5, in which each seller is represented by a software agent.

8. A method according to Claim 5, comprising the use of an intermediate software agent between the buyers and the or each seller, for negotiating a contract between the or each seller and the collective buyers.

9. A method according to Claim 6, in which each software agent comprises a transaction engine; a negotiation engine driven by the transaction engine; and a store of a plurality of negotiation profiles; and control means responsive to the commercial situation or state of the party to select the optimal negotiation profile appropriate to that situation or state, and to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile.

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10. An intermediate re-selling software agent for use on an electronic network for negotiating contracts between at least one buyer and at least one seller, by purchasing from a seller and re-selling it to a buyer.

11. An intermediate re-selling software agent according to Claim 10, which comprises a transaction engine; a negotiation engine driven by the transaction engine; and a store of a plurality of negotiation profiles; and control means responsive to the commercial situation or state of the party to select the optimal negotiation profile appropriate to that situation or state, and to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile.

12. An intermediate negotiation system for e-commerce comprising multiple software agents capable of being engaged by buyers and/or sellers, and an interface for negotiating contracts between respective agents of at least one buyer

13. An intermediate negotiation system according to Claim 12, arranged to conduct an automated reverse auction on an electronic network using software agents for buyers and sellers.

14. An intermediate negotiation system according to Claim 12, in which each software agent comprises a transaction engine; a negotiation engine driven by the transaction engine; and a store of a plurality of negotiation profiles; and control means responsive to the

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commercial situation or state of the party to select the optimal negotiation profile appropriate to that situation or state, and to cause the transaction engine to initiate or conduct e-commerce negotiations using the negotiation engine programmed with the selected negotiation profile.

I 15. A system according to Claim 1, in which each software agent is a component of a distributed architecture.

16. A system according to Claim 12, in which each software agent is a component of a distributed architecture.

17. A method according to Claim 3, in which each software agent is a component of a distributed architecture.

18. A method according to Claim 5, in which each software agent is a component of a distributed architecture.

19. A software agent according to Claim 2, in which the negotiation engine is a component of a distributed architecture.

20. An intermediate re-selling software agent according to Claim 10, which is a component of a distributed architecture.

21. An intermediate negotiation system according to Claim 12, which is a component of a distributed architecture.

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- 22. A system according to Claim 1, in which the software is implemented as
- 23. A communications network comprising a system according to Claim 1.
- 24. A communications network according to Claim 23, in which the network consists of the Internet.
- 25. A computer program for creating a system according to Claim 1.
- 26. A computer program for creating a software agent according to Claim 2.



JEFFREY PWJ
PRIMARY EXAMINER